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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK JOSEPHUS LUCIEN MARIA VAN DOMMELEN and
PAULUS ALERTUS MARIA VERMEULEN

Appeal 2007-2123
Application 09/873,564
Technology Center 2800

Decided: March 11, 2008

Before KENNETH W. HAIRSTON, ALLEN R. MACDONALD, and ROBERT E. NAPPI, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 3, and 4. We have jurisdiction under 35 U.S.C. § 6(b).

According to Appellants, the invention is a high-pressure discharge lamp comprising a discharge vessel which is enveloped with clearance by an outer bulb provided with a lamp cap, which outer bulb is translucent (Spec. 1:2-4). The outer bulb is provided with a light-scattering layer which forms an internal electrostatic coating (Spec. 1:25, 1:29, and 3:1).

Representative Claim(s)

Claims 1, 3, and 4 under appeal read as follows:

> 1. A high-pressure discharge lamp comprising a discharge vessel which is enveloped with clearance by an outer bulb provided with a lamp cap, which outer bulb is translucent, is substantially tubular in shape, and is provided with a light-scattering layer.
>
> 3. A lamp as claimed in claim 1, characterized in that the light-scattering layer forms an electrostatic coating.
>
> 4. A lamp as claimed in claim 1, characterized in that the outer bulb is internally provided with the light-scattering layer.

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Thornton	US 4,315,193	Feb. 9, 1982
Kinczel	US 5,004,948	Apr. 2, 1991
Carleton	US 5,008,583	Apr. 16, 1991
Verschueren	US 5,612,585	Mar. 18, 1997
Whitman	US 5,723,937	Mar. 3, 1998

The Board relies on additional prior art as follows:

Larson	US 3,110,833	Feb. 21, 1961
Fromm	US 4,171,498	Oct. 16, 1979
Kawakatsu	US 4,721,877	Jan. 26, 1988

Rejections

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Verschueren and Whitman.[1]

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Verschueren, Whitman, Thornton, and Kinczel.

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Verschueren, Whitman, and Carleton.

Appellants' Contentions

(1) Appellants contend that the subject matter of claim 1 would not have been obvious. More specifically, Appellants contend that the Examiner erred in rejecting claim 1 because:

(A) Verschueren does not teach or suggest that the particular shape (tubular) has any particular advantage (App. Br. 5).

(B) Verschueren does not teach or suggest the application of any coatings to the surface of the outer bulb (App. Br. 5).

(C) Whitman does not teach or suggest a high-pressure discharge lamp with an outer envelope (App. Br. 6).

(D) A skilled artisan would not be led to apply teachings regarding lamps and structures of very different types (such as Whitman's) to a high-pressure discharge lamp (such as Verschueren's) (App. Br. 6).

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[1] In the Examiner's Final Rejection, claim 3 is mistakenly included in the statement of this ground of rejection, but the analysis that follows fails to include claim 3. The Examiner corrects this ground of rejection in the Answer to limit it to claim 1 only.

(E) Whitman's coatings are applied to parabolic reflectors and lenses for incandescent lamps, and Whitman does not suggest the desirability of applying such coatings to other lamp types or structures, thus it would not be obvious in view of Whitman to add coatings to the outer bulb of Verschueren's lamp (App. Br. 6).

(F) Whitman teaches that the lamp may be surrounded by a shroud but does not teach such use in a discharge lamp and even if Whitman did teach such, it would not suggest the use of a light scattering coating on the outer envelope of a discharge lamp (Reply Br. 2).

(G) Whitman's teachings of placement of light-scattering coatings on the discharge lamp and on the shroud would lead the skilled artisan away from Appellants' invention; and the general statement of Whitman that "Other lamps, lamp types, and lamp configurations can also be used in accordance with [Whitman's] invention" does not teach or suggest to the skilled artisan to add a light-scattering coating to the outer envelope of a discharge lamp (Reply Br. 2-3).

(H) Appellants combine a tubular-shaped outer bulb and a light-scattering layer, in order to avoid incurring an unacceptable thermal load, and the combination of Verschueren and Whitman fails to teach or suggest such a unique combination of features (Reply Br. 3).

(2) Appellants contend that the subject matter of claim 3 would not have been obvious. More specifically, Appellants contend that the Examiner erred in rejecting claim 3 because:

(A) Kinczel describes a luminescent coating 2 consisting of one or two layers, which can be prepared by electrostatic methods, but does not mention (i) a "light-scattering" layer, (ii) that coating 2 has light-scattering properties, or (iii) an electrostatic coating process for a light-scattering layer (App. Br. 7).

(B) Kinczel's discussion with respect to electrostatic coating relates to the luminescent phosphor coatings, not to light-scattering coatings (Reply Br. 3).

(C) Light-scattering coatings have different functions, and therefore the coating materials and resulting coatings have different physical and chemical properties than do luminescent coating materials and coatings (Reply Br. 4).

(D) Thornton describes phosphor materials coated as a layer using a dry electrostatic precipitation technique and a second layer of light-scattering material, but does not mention the coating technique for the second layer (App. Br. 7).

(3) Appellants contend that the subject matter of claim 4 would not have been obvious. More specifically, Appellants contend that the Examiner erred in rejecting claim 4 because:

(A) Carleton teaches that light-scattering layers cannot be employed on outer envelopes having shapes other than ovoidal or similar shapes, thus, Carleton at least strongly suggests that light-

scattering layers cannot be used on tubular outer envelopes like those of Verschueren and Appellant (App. Br. 9).

Result

We affirm.

ISSUE(S)

Have Appellants established that the Examiner erred in rejecting claim 1 as being unpatentable under 35 U.S.C. § 103(a) over Verschueren and Whitman?

Have Appellants established that the Examiner erred in rejecting claim 3 as being unpatentable under 35 U.S.C. § 103(a) over Verschueren, Whitman, Thornton, and Kinczel?

Have Appellants established that the Examiner erred in rejecting claim 4 as being unpatentable under 35 U.S.C. § 103(a) over Verschueren, Whitman, Thornton, Kinczel, and Carleton?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Admission

1. Appellants' invention leads to a higher thermal load on the coating as compared to the known lamp (Spec. 2, ll. 6-8).

Verschueren

2. Verschueren describes high-pressure discharge lamp comprising a discharge vessel which is enveloped with clearance by an outer

bulb provided with a lamp cap, which outer bulb is translucent (col. 1, ll. 6-11; apparatus shown in Fig. 1).

Whitman

3. Whitman describes using a light-scattering coating on lamps (col. 1, ll. 6-11).

4. Whitman describes using the light-scattering coating with a lamp comprising a light-transmissive lamp envelope enclosing a source of electric light within, wherein the coating is disposed on the surface of the lamp envelope, the coating scatters the visible light emitted by the source, thereby diffusing the light source image in the light emitted by the lamp. The light source may be either an arc discharge or a filament (col. 1, ll. 50-57).

5. Whitman's invention is not limited to the particular embodiment of a lamp comprising a fused quartz envelope having a filament as the light source hermetically sealed within, with the outer surface of the lamp envelope coated with a light-scattering coating according to the invention. Other lamps, lamp types and lamp configurations can also be used in accordance with the invention (col. 2, ll. 52-58).

6. Whitman describes the light-scattering coating in various embodiments (col. 2, ll. 47-48; element 26 of Figures 1(a), 1(b), 2(a), 2(b), 2(c) and 3).

7. Whitman describes that the light-scattering coating 26 according to the invention can be disposed on the outer surface of glass lens 86 (Fig. 3; col. 3, ll. 61-63).

Kinczel

8. Kinczel describes a high-pressure mercury vapor gas discharge lamp where an outer envelope 1 is applied for determining an inner space comprising a hermetically sealed discharge vessel (col. 7, ll. 56-59; FIG. 5).

9. The outer envelope 1 is covered on its inner surface by a luminescent coating 2 (col. 7, ll. 67-68).

10. The luminescent coating 2 can be prepared by any known method; especially the electrostatic methods are preferred (col. 8, ll. 13-15).

Thornton

11. Thornton describes a high-pressure mercury-vapor lamp incorporating a special phosphor mixture on the interior surface of the outer envelope (abstract).

12. Thornton describes that the phosphor is coated as a layer using a dry electrostatic precipitation technique (col. 3, l. 63 through col. 4, l. 1).

13. Thornton describes that an alternative embodiment may include a layer of light-scattering material such as silica which is first coated onto the interior surface 36 of the outer envelope and the phosphor coated thereover (col. 4, ll. 18-22).

Carleton

14. Carleton describes a high-pressure sodium discharge lamp provided with an elongate discharge vessel enclosing a discharge space and having an outer envelope, which is closed by a lamp cap (col. 1, ll. 5-14).

15. Carleton describes that a known prior art lamp of this type is provided with an ovoidal outer envelope, which is coated in practice on its inner side with a light-scattering layer (col. 1, ll. 24-29).

16. Carleton describes that having the prior art light-scattering layer limits the choice of the shape of the envelope to an ovoidal or similar shape, in order to achieve the result that the temperature of the light-scattering layer remains acceptable during operation of the lamp (col. 1, ll. 56-60).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR* at 11 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

Under this framework, once an Examiner demonstrates that the elements are known in the prior art and that one of ordinary skill could

combine the elements as claimed by known methods and would recognize that the capabilities or functions of the combination are predictable, then the Examiner has made a prima facie case that the claimed subject matter is likely to be obvious. The burden then shifts to the Appellant to show that the Examiner erred in these findings or to provide other evidence to show that the claimed subject matter would have been nonobvious.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR.*, 127 S. Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS – CLAIM 1

(1)(A)

Appellants contend that the Examiner has erred because Verschueren does not teach or suggest that the particular shape (tubular) has any particular advantage (App. Br. 5).

We disagree. Appellants' contention fails to set forth any reason why this allegation, even if presumed correct, demonstrates that the Examiner erred. We conclude that this allegation is not relevant to the rejection before us.

(1)(B) and (1)(C)

Appellants contend that the Examiner has erred because Verschueren does not teach or suggest the application of any coatings to the surface of the outer bulb (App. Br. 5); and Whitman does not teach or suggest a high-pressure discharge lamp with an outer envelope (App. Br. 6).

We disagree. Appellants' arguments focus on the individual differences between the limitations of claim 1 and the Verschueren and Whitman references. It is apparent, however, from the Examiner's line of reasoning in the Final Rejection, that the basis for the obviousness rejection is the combination of Verschueren and Whitman. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1096 (Fed. Cir. 1986).

In other words, while Appellants contend that Verschueren lacks a teaching, it is our view that such feature is taught by Whitman for the reasons set forth by the Examiner. Similarly, while Appellants contend that Whitman lacks a teaching, this teaching is clearly provided by Verschueren.

(1)(D)

Appellants contend that the Examiner has erred because a skilled artisan would not be led to apply teachings regarding lamps and structures of very different types (such as Whitman's) to a high-pressure discharge lamp (such as Verschueren's) (App. Br. 6).

We disagree. Appellants' contention is nothing more than a bare allegation without any supporting argument or evidence. As such, it does not demonstrate that the Examiner has erred.

(1)(E)

Appellants contend that the Examiner has erred because Whitman's coatings are applied to parabolic reflectors and lenses for incandescent lamps, and Whitman does not suggest the desirability of applying such

coatings to other lamp types or structures, thus it would not be obvious in view of Whitman to add coatings to the outer bulb of Verschueren's lamp (App. Br. 6).

We disagree. Whitman explicitly states that "[o]ther lamps, lamp types, and lamp configurations can also be used in accordance with [Whitman's] invention" (col. 2, ll. 57-58).

(1)(F)

Appellants contend that the Examiner has erred because Whitman teaches that the lamp may be surrounded by a shroud but does not teach such use in a discharge lamp and even if Whitman did teach such, it would not suggest the use of a light scattering coating on the outer envelope of a discharge lamp (Reply Br. 2).

We disagree. Appellants' contention fails to set forth any reason why this allegation, even if presumed correct, demonstrates that the Examiner erred since the shroud is not referenced in the Final Rejection on appeal. We conclude that this allegation is not relevant to the rejection before us.

(1)(G)

Appellants contend that the Examiner has erred because Whitman's teachings of placement of light-scattering coatings on the discharge lamp and on the shroud would lead the skilled artisan away from Appellants' invention; and the general statement of Whitman that "[o]ther lamps, lamp types, and lamp configurations can also be used in accordance with [Whitman's] invention" does not teach or suggest to the skilled artisan to add a light-scattering coating to the outer envelope of a discharge lamp (Reply Br. 2-3).

We disagree. Appellants' contention is nothing more than a bare allegation without any supporting argument or evidence. As such, it does not demonstrate that the Examiner has erred. Further, Appellants' contention is countered by Whitman's explicit teaching of placing the coating on outer surface of glass lens 86 (FF 7).

(1)(H)

Appellants contend that the Examiner has erred because Appellants combine a tubular-shaped outer bulb and a light-scattering layer, in order to avoid incurring an unacceptable thermal load, and the combination of Verschueren and Whitman fails to teach or suggest such a unique combination of features (Reply Br. 3).

We disagree. Appellants' contention is nothing more than a bare allegation without any supporting argument or evidence. Further, Appellants' contention is countered by Appellants' explicit admission that the instant invention leads to a higher thermal load as compared to the known lamp (FF 1).

Conclusion

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claim 1 under § 103(a).

ANALYSIS – CLAIM 3

(2)(A) through (2)(D)

Appellants contend that the Examiner has erred because Kinczel describes a luminescent coating 2 consisting of one or two layers, which can be prepared by electrostatic methods, but does not mention a

"light-scattering" layer, that coating 2 has light-scattering properties, or an electrostatic coating process for a light-scattering layer (App. Br. 7); Kinczel's discussion with respect to electrostatic coating relates to the luminescent phosphor coatings, not to light-scattering coatings (Reply Br. 3); Thornton describes phosphor materials coated as a layer using a dry electrostatic precipitation technique and a second layer of light-scattering material, but does not mention the coating technique for the second layer (App. Br. 7); and light-scattering coatings have different functions, and therefore the coating materials and resulting coatings have different physical and chemical properties than do luminescent coating materials and coatings (Reply Br. 4).

We disagree. Appellants' contentions require that we first review the Examiner's final rejection of claim 3 (Final Rej. 3). We find the following finding of fact set forth by the Examiner: "Both Thornton and Kinczel disclose electrostatic coating processes for light scattering layers (for example, see Thornton column 3, lines 67-column 4, line 2, see Kinczel et al column 7, line 55 – column 8, line 16)." Our review of these cited passages finds that they refer solely to phosphor or luminescent coatings being applied by electrostatic methods. We conclude that the Examiner has not relied on any explicit teaching of a "light-scattering layer" found in these references. Thus, Appellants' contentions that Kinczel does not explicitly mention a "light-scattering" layer, and Thornton does not mention the coating technique for the second light-scattering layer are not relevant to the

rejection on appeal. The rejection before relies solely on the phosphor layers and with that it relies on the phosphor layer having the claimed light-scattering property.

Therefore, the issue before us turns on the properties of the luminescent phosphor coatings found in Kinczel and Thornton (addressed in Appellants' contentions (2)(A)(ii) and (2)(C)). We note that while the structural requirements of the "electrostatic coating" product-by-process limitation of claim 3 can be met by any coating applied by any process, the Examiner has provided prior art that explicitly describes using a electrostatic coating technique to place the luminescent phosphor coatings.

As to the properties of phosphor coatings, Appellants' contentions (2)(A)(ii) and (2)(C) are nothing more than bare allegations without any supporting argument or evidence. As such, it does not demonstrate that the Examiner has erred.

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255. *See also Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

Separately, we point out that Appellants are simply wrong as to their allegation that a phosphor coating does not have a light-scattering property. See Larson U.S. 3,110,833, at column 1, lines 40-41, "phosphor tends to scatter the light which is emitted by the arc tube."

Conclusion

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claim 3 under § 103(a).

ANALYSIS – CLAIM 4

(3)(A))

Appellants contend that the Examiner has erred because Carleton teaches that light-scattering layers cannot be employed on outer envelopes having shapes other than ovoidal or similar shapes, thus, Carleton at least strongly suggests that light-scattering layers cannot be used on tubular outer envelopes like those of Verschueren and Appellant (App. Br. 9).

We disagree. Carleton describes that having the prior art light-scattering layer limits the choice of the shape of the envelope to an ovoidal or similar shape, in order to achieve the result that the temperature of the light-scattering layer remains acceptable during operation of the lamp (col. 1, ll. 56-60). We find that this does not state as Appellants contend "that light-scattering layers cannot be used on tubular outer envelopes." Rather, we conclude that the language "remains acceptable" indicates that it will work, but poorly. Being less effective is not a teaching away. "A known or obvious composition does not become patentable simply because it has been

described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Conclusion

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claim 4 under § 103(a).

VI. NEW GROUNDS OF REJECTION

A. *35 U.S.C. § 102(b)*

We reject claims 1, 3, and 4 under 35 U.S.C. § 102(b) and 103(a), using our authority under 37 C.F.R. § 41.50(b).

B. *35 U.S.C. § 102(b) – Fromm*

We reject claims 1, 3, and 4 under 35 U.S.C. § 102(b), as being anticipated by Fromm.

Findings of fact

17. Fromm describes a high pressure electric discharge lamp (col. 1, ll. 6-7).

18. Fromm's figure 2 describes a lamp embodiment comprising all the structural features of Appellants' claims 1, 3, and 4.

19. Fromm describes that the arc tube is surrounded by an outer envelope which may suitably be coated on its inner surface wholly or partly with a phosphor material (col. 2, ll. 61-65; and col. 4, ll. 13-15).

Analysis

The findings of fact above show that Fromm describes all of the structural limitations of Appellants' claims 1, 3, and 4. Fromm fails to

mention (i) that light-scattering is a property of the phosphor coating, or (ii) that an electrostatic technique is used to make the phosphor layer. However, it is known in the art that "phosphor tends to scatter the light which is emitted by the arc tube." See Larson U.S. 3,110,833, at column 1, lines 40-41. Further, the "electrostatic" product-by-process limitation of claim 3 does not set forth any structural requirement on the coating other than those shown by coating 18 in figure 2 of Fromm.

C. *35 U.S.C. § 103(a) – Kawakatsu and Verschueren*

We reject claims 1, 3, and 4 under 35 U.S.C. § 103(a), as being obvious over the descriptions of Kawakatsu and Verschueren.

Findings of fact

20. Kawakatsu describes a light diffusive coating which is formed on a base surface of lamps such as halogen lamps, high pressure discharge lamp bulbs, . . . (col. 1, ll. 7-9).

21. Kawakatsu describes that the light diffusive coating can be applied without problem to the inside or outside of the base surface of lamps, etc., regardless of their material (col. 1, ll. 60-65).

22. Kawakatsu describes that the light diffusive coating can be various materials including silica (col. 3, ll. 31-44).

23. Kawakatsu describes that the light diffusive coating can be formed by dipping (col. 4, ll. 23-24).

24. Kawakatsu describes that it is known in the prior art to use methods of forming a light diffusive coating by applying a fine diffusive powder such as silica to the outside of the lamp by electrostatic coating (col. 1, ll. 27-30).

25. Kawakatsu describes that the light diffusion effect of the light diffusive coating 3 may also be strengthened by combination with the pre-existing technology of dispersing particles of other metal compounds within the light diffusive coating material 31 (col. 6, ll. 41-45).

26. Kawakatsu describes that the invention is not limited to applying the light diffusive coating to the outside surface of a tube. Rather, it may also be formed on any surface, such as the inside surface of a halogen lamp, on the inside or outside surfaces of ordinary lamps and infra-red lamps, etc., using soft glass such as soda lime glass or hard glass such as borosilicate glass, on the inside or outside surfaces of the vessel of high pressure discharge lamps, or on plate glass such as optical filters or window glass (col. 8, ll. 3-12).

27. Kawakatsu describes that the surfaces on which the coating may be formed are given the generic name "base" (col. 8, ll. 12-14).

Analysis

The findings of fact above show that Kawakatsu describes all of the structural limitations of Appellants' claims 1, 3, and 4, except that the high-pressure discharge lamp comprises an outer bulb being tubular in shape. Figure 1 of Verschueren teaches that such an outer bulb shape is known in the art. Since each individual element and its function, as described in the claims, are shown in the prior art, albeit shown in separate references, the

difference between the claimed subject matter and that of the prior art rests not on any individual element or function but in the very combination itself.

Where, as here, the application claims the combination of familiar elements according to known methods, it is likely to be obvious when it does no more than yield predictable results. KSR, 127 S. Ct. at 1739. Appellants' Specification does not present any evidence that using the method of Kawakatsu on the bulb of Verschueren would be uniquely challenging or difficult for one of ordinary skill in the art.

Accordingly, we conclude that the subject matter of claims 1, 3, and 4, would have been obvious to one of ordinary skill in the art given the teachings of Kawakatsu and Verschueren.

D. *37 C.F.R. § 41.50(b)*

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
>
> (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

CONCLUSION OF LAW

(1) Appellants have failed to establish that the Examiner erred in rejecting claims 1, 3, and 4, as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1, 3, and 4, are not patentable.

(3) Since we have entered a new rejection, our decision is not a final agency action.

DECISION

The Examiner's rejections of claims 1, 3, and 4 are affirmed.

We reject claims 1, 3, and 4, under 35 U.S.C. § 102(b) and 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

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